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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,445	11/30/2004	Andrew Jamieson	2222.5970001	2996

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3687

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03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/516,445	<b>Applicant(s)</b> JAMIESON, ANDREW	
	<b>Examiner</b> VANEL FRENEL	<b>Art Unit</b> 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/31/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Remarks filed on 12/31/08. Claims 33-64 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houvener et al. (6,016,480) in view of Fitzgerald et al. (2001/0037249).

As per claim 33, Houvener discloses a display device for a personal device to perform financial transactions as well as personal functions other than financial transactions, the display device comprising; a display for displaying information to a user (See Houvener, Col.3, lines 16-36).

Houvener does not explicitly disclose a financial transaction controller coupled to the display, wherein the financial transaction controller selectively allows the display and an input device to operate under the control of the personal device to enable personal functions other than financial transactions to be performed, and wherein the financial transaction controller assumes control of the display and the input device to prevent

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tampering with or tapping off of data entered into the input device or stored in the financial transaction controller during a financial transaction.

However, these features are known in the art, as evidenced by Fitzgerald. In particular, Fitzgerald suggests that the display having a financial transaction controller coupled to the display, wherein the financial transaction controller selectively allows the display and an input device to operate under the control of the personal device to enable personal functions other than financial transactions to be performed, and wherein the financial transaction controller assumes control of the display and the input device to prevent tampering with or tapping off of data entered into the input device or stored in the financial transaction controller during a financial transaction (See Fitzgerald, Page 2, Fig.3; Paragraph 0034).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Fitzgerald within the system of Houvener with the motivation of providing a handheld mobile financial transaction terminal said terminal including a secure keypad (See Fitzgerald, Page 1, Paragraphs 0008-0010).

As per claim 34, Fitzgerald discloses the display device wherein the financial transaction controller is an electronic funds transfer point of sale (EFTPOS) controller that includes a processor, a display driver connected to the processor and a secure memory coupled to the processor, and wherein the secure memory stores secure data and the processor is coupled to the display by the display driver (See Fitzgerald, Page 2, Paragraphs 0036-0038).

As per claim 35, Fitzgerald discloses the display device wherein the personal device includes controlling electronics, and wherein the display device includes circuitry for coupling the processor to the input device and the controlling electronics of the personal device (See Fitzgerald, Fig.3; Page 3, Paragraphs 0044-0045).

As per claim 36, Fitzgerald discloses the display device wherein the financial transaction controller is physically attached to the display (See Fitzgerald, Page 3, Paragraph 0039).

As per claim 37, Fitzgerald discloses the display device wherein the financial transaction controller is integrated with the display (See Fitzgerald, Page 3, Paragraph 0039).

As per claim 38, Fitzgerald discloses the display device wherein the financial transaction controller is integrated with the display by connecting the financial transaction controller to a printed circuit board (PCB) that includes a display driver for controlling the display (See Fitzgerald, Page 3, Paragraphs 0038-0041).

As per claim 39, Fitzgerald discloses the display device wherein the display is a liquid crystal display (LCD) having a glass face and the financial transaction controller is directly mounted onto the glass face of the LCD by a chip on glass process (See Fitzgerald, Page 3, Paragraphs 0044-0046).

As per claim 40, Fitzgerald discloses the display device wherein the display device is coupled to the controlling electronics of the personal device by a zero insertion force connector, and wherein disconnection of the display device from the controlling electronics provides a trigger signal that causes data within the financial transaction controller to be erased to prevent unauthorized access of the data (See Fitzgerald, Page 3, Paragraphs 0044-0046).

As per claim 41, Fitzgerald discloses the display device wherein a circuit loop-back in the zero insertion force connector provides the trigger signal to the financial transaction controller, and wherein the data includes a banking key (See Fitzgerald, Page 2, Paragraph 0034).

As per claim 42, Fitzgerald discloses the display device wherein the input device is a keypad (See Fitzgerald, Page 3, Paragraph 0039; Paragraph 0044).

As per claim 43, Fitzgerald discloses the display device wherein the financial transaction controller is an application specific integrated circuit (ASIC) (See Fitzgerald, Page 1, Paragraph 0002).

As per claim 44, Fitzgerald discloses the display device wherein the financial transaction controller is a hybrid circuit (See Fitzgerald, Page 2, Paragraph 0033).

As per claim 45, Fitzgerald discloses the display device wherein the financial transaction controller is configured to selectively control a plurality of different displays that may be used in different types of personal devices (See Fitzgerald, Page 3, Paragraph 0042; Paragraph 0044).

As per claim 46, Fitzgerald discloses the display device wherein the personal device includes a communication circuit for transmitting data relating to the financial transactions to a financial transaction network and for receiving data from the financial transaction network (See Fitzgerald, Page 3, Paragraphs 0037-0042).

As per claim 47, Fitzgerald discloses the display device wherein the personal device includes an input for activation by an operator to place the display device in a secure condition for performing a financial transaction (See Fitzgerald, Page 2, Paragraphs 0036-0039).

As per claim 48, Houvener discloses a financial transaction device for performing financial transactions as well as personal functions other than financial transactions, the device comprising: an input device for the entry of data into the financial transaction device (See Houvener, Col.3, lines 16-36); a display for displaying information to a user (See Houvener, Col.3, lines 16-36); a financial transaction controller coupled to the display and the input device (See Houvener, Col.4, lines 60-67).

Houvener does not explicitly disclose a personal device including controlling electronics coupled to the financial transaction controller, wherein the personal device is configured to control the financial transaction device to perform personal functions other than financial transactions, and wherein the financial transaction controller selectively allows the display and the input device to operate under the control of the controlling electronics to enable personal functions other than financial transactions, where the financial transaction controller assumes control of the display and the input device to prevent the controlling electronics from accessing the display and the input device to prevent tampering with or tapping off of data entered into the input device or stored in the financial transaction controller during a financial transaction.

However, these features are known in the art, as evidenced by Fitzgerald. In particular, Fitzgerald suggests that the financial transaction having a personal device including controlling electronics coupled to the financial transaction controller, wherein the personal device is configured to control the financial transaction device to perform personal functions other than financial transactions, and wherein the financial transaction controller selectively allows the display and the input device to operate under the control of the controlling electronics to enable personal functions other than financial transactions, where the financial transaction controller assumes control of the display and the input device to prevent the controlling electronics from accessing the display and the input device to prevent tampering with or tapping off of data entered into the input device or stored in the financial transaction controller during a financial transaction (See Fitzgerald, Page 2, Paragraph 0034).



It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Fitzgerald within the system of Houvener with the motivation of providing a handheld mobile financial transaction terminal said terminal including a secure keypad (See Fitzgerald, Page 1, Paragraphs 0008-0010).

As per claim 54, Fitzgerald discloses wherein the financial controlling electronics include a communication circuit for transmitting and receiving information (See Fitzgerald, Page 3, Paragraphs 0037-0042).

As per claim 55, Houvener discloses a mobile telephone for performing financial transactions as well as mobile telephone calls other than financial transactions, the mobile telephone comprising: an input device for the entry of data into the mobile telephone (See Houvener, Col.3, lines 16-36); a display for displaying information to a user (See Houvener, Col.3, lines 16-36); controlling electronics for enabling a mobile telephone call to be performed with the mobile telephone(See Houvener, Col.3, lines 16-36).

Houvener does not explicitly disclose a financial transaction controller coupled to the display, wherein the financial transaction controller selectively allows the input device and the display to be coupled to the controlling electronics to enable mobile telephone calls other than financial transactions, and wherein the financial transaction controller disconnects the controlling electronics from the display and the input device

and assumes control of the display and the input device to perform a financial transaction.

However, these features are known in the art, as evidenced by Fitzgerald. In particular, Fitzgerald suggests that the financial transaction having a financial transaction controller coupled to the display, wherein the financial transaction controller selectively allows the input device and the display to be coupled to the controlling electronics to enable mobile telephone calls other than financial transactions, and wherein the financial transaction controller disconnects the controlling electronics from the display and the input device and assumes control of the display and the input device to perform a financial transaction(See Fitzgerald, Page 2, Fig.3; Paragraph 0034; Page 3, Paragraphs 0044-0047).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Fitzgerald within the system of Houvener with the motivation of providing a handheld mobile financial transaction terminal said terminal including a secure keypad (See Fitzgerald, Page 1, Paragraphs 0008-0010).

As per claim 61, Fitzgerald discloses the telephone wherein the display is a liquid crystal display (LCD) having a glass face and the financial transaction controller is directly mounted onto the glass face of the LCD by a chip on glass process (See Fitzgerald, Page 3, Paragraph 0044).

As per claim 62, Fitzgerald discloses the telephone wherein the financial transaction controller enables communication between the controlling electronics, the display and the input device during the performance of personal functions other than financial transactions (See Fitzgerald, Page 2, Paragraph 0034).

As per claim 63, Fitzgerald discloses the telephone wherein the controlling electronics cannot access the display or the input device during a financial transaction, and wherein the financial transaction controller communicates with the controlling electronics to facilitate data transmission and reception for a financial transaction in a mobile telephone call to a financial system network (See Fitzgerald, Page 2, Paragraph 0033).

As per claim 64, Fitzgerald discloses the telephone wherein the input device is a keypad (See Fitzgerald, Page 2, Paragraph 0034).

Claims 49-53 and 56-61 recite the underlying process steps of the elements of claims 34-47, and respectively. As the various elements of claims 34-47 have been shown to be either disclosed by or obvious in view of the collective teachings of Houvener and Fitzgerald, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 49-53, 56-61 are rejected for the same reasons given above for claims 34-47, and incorporated herein.

***Response to Arguments***

4. Applicant's arguments filed on 12/31/08 with respect to claims 33-64 have been fully considered but they are not persuasive.

(A) At pages 10-13 of the response filed on 12/31/08, Applicant's argues the followings:

(i) Fitzgerald does not teach or suggest "a financial transaction controller coupled to the display".

(ii) The combination of Houvener and Fitzgerald does not teach or suggest each and every feature of independent claims 33, 48 and 55, and therefore does not render them obvious.

(B) With respect to Applicant's first argument, the Examiner respectfully submitted that He relied upon the teaching of Fitzgerald (See Fitzgerald, Fig.3, Page 2, Paragraph 0034) which correspond to Applicant's claimed feature. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second argument, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147

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(CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches security system for non-cash transactions (5,615,110) and mobile funds transaction device for transferring funds between remote banking facilities (6,010,067).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nanel Frenel/

Examiner, Art Unit 3687

March 7, 2009